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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,981	01/16/2002	Ryuzo Ueno	OHS-315	9139

7590 09/23/2003
Sherman & Shalloway
413 North Washington Street
Alexandria, VA 22314

EXAMINER

HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/23/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,981

Applicant(s)

UENO ET AL.

Examiner

Patricia L. Hailey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-8, and 15-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8 and 15-20 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 21-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Applicants' remarks and amendments, filed on June 30, 2003, have been carefully considered.

Claims 3 and 9-14 have been canceled; no new claims have been added.

Claims 1, 2, 4-8, and 15-34 remain pending in this application.

In the previous Office Action, the Examiner indicated claims 6-8 as being allowed and claims 15-20 were objected to as being dependent on a rejected base claim. Claims 15-20 should also have been indicated as being allowable, as they all depend from claims 6-8. The Examiner apologizes for the oversight, and appreciates Applicants' for making the oversight known to the Examiner.

Priority

The requirement for a certified copy of the foreign priority document has been reconsidered and is withdrawn.

Withdrawn Rejections

The provisional obviousness-type double patenting rejection of claims 1, 2, 4, and 5 as being unpatentable over claims 1, 2, and 13 of copending Application Serial No. 09/958,666 has been withdrawn in view of Applicants' amendments to claim 1.

The 102(e) rejection of claims 1, 2, 4, and 5 as being anticipated by Willibald-Ettle et al. (U. S. Patent No. 6,458,400) has been withdrawn in view of Applicants' persuasive arguments relating thereto and in view of Applicants' amendments to claim 1.

Maintained Rejection

The following rejection has been maintained:

Claim Rejections - 35 USC § 103

1. Claims 1, 2, 4, 5, and 21-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Degelmann et al. (U. S. Patent No. 6,103,894).

Degelmann et al. teach a process for the hydrogenation of sugars selected from the group consisting of isomaltulose, leucrose, trehalulose, maltulose, and lactulose to sugar alcohols (col. 1, line 52 to col. 2, line 37). The hydrogenation of isomaltulose can result in a composition comprising 1,1-GPM and a mixture of 1,6-GPS and 1,1-GPS in percentage ranges comparable to that instantly claimed. See Examples 3 and 9, and Tables 5 and 13 of Degelmann et al.

Although the reference does not specifically disclose separate amounts of 1,6-GPS and 1,1-GPS in the mixture, one of ordinary skill in the art would expect that the amounts of these two components would read upon the instantly claimed percentage ranges, absent the showing of convincing evidence to the contrary. That is, if 1,1-GPS is present in the mixture of 1,6-GPS and 1,1-GPS in an amount within the respectively claimed range, the remaining amount of the mixture comprises 1,6-GPS in an amount within the claimed range of 1 to 50 wt. % 1,6-GPS (e.g., claim 2).

Because Degelmann et al. is considered to read upon the claims in their present form, any attending properties of the claimed composition (e.g., specific surface area) are considered to be encompassed by the composition of Degelmann et al. It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

With respect to product-by-process claims 21-34, "[A]ny difference imparted by the product by process limitations would have been obvious to one having ordinary skill in the art at the time the invention was made because where the examiner has found a substantially similar product as in the

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applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct, not the examiner to show that the same is a process of making." In re Brown, 173 U.S.P.Q. 685 and In re Fessmann, 180 U.S.P.Q. 324.

Product-by-process claims do not patentably distinguish the product of reference even though made by a different process. In re Thorpe, 227 U.S.P.Q. 964.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

The 103(a) rejection is maintained because it appears that Applicants have argued the teachings of Degelmann et al., U. S. Patent No. 6,414,138, as opposed to U. S. Patent No. 6,103,894. For example, col. 1, lines 46-48 of Degelmann et al. '138 refers to dissolving hydrogenated isomaltulose in water and cooling the solution to crystallize it and to obtain "the desired phase composition." Col. 1, lines 46-48 of Degelmann et al. '894 states: "It is also desirable to improve the process flow, the handling of the catalysts and the process costs of the conventional processes."

For these reasons, Applicants' arguments are not persuasive.

Allowable Subject Matter

3. Claims 6-8 and 15-20 allowed.

4. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not teach or suggest the limitations of claims 6-8 and 15-20, namely the steps of cooling a composition comprising 1,1-GPM, 1,6-GPS, and 1,1-GPS, mixing this composition with a hydrophilic solvent, and separating solid matter from the mixture.

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Conclusion


5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (703) 308-3317. The examiner can normally be reached on Mondays-Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.


Lynn Hailey/plh
Examiner, Art Unit 1755
September 22, 2003


C. MELISSA KOSLOW
PRIMARY EXAMINER